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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/426,567	10/22/1999	DAVID BANKS	3676	2060

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EXAMINER

HARPER, KEVIN C

ART UNIT	PAPER NUMBER
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2666

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DATE MAILED: 12/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/426,567	Applicant(s) BANKS ET AL.	
	Examiner Kevin C. Harper	Art Unit 2666	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 11-13, 15-29 and 32-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 47-50 is/are allowed.
- 6) ☒ Claim(s) 1-3, 11, 15-23, 26-28, 32, 33, 39-43 and 46 is/are rejected.
- 7) ☒ Claim(s) 4-6, 12, 13, 24, 25, 29, 34-38, 44 and 45 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

Response to Arguments

Applicant's arguments with respect to claims 1-6, 11-13, 15-29 and 32-50 have been considered but are moot in view of the new ground(s) of rejection. The indicated allowability of claim 21 is withdrawn in view of the newly discovered reference(s) to Berman (US 2003/0095549). Rejections based on the newly cited reference(s) follow.

Drawings

1. Drawings were received on February 25, 2002. These drawings are approved.

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

2. Claims 37-38 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 7-10 and 30 of copending Application No. 10/059,753. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented. Claims 37-38, as dependent upon claim 33, recite the same limitations as claims 7-10 and 30 of the copending application.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir.

Art Unit: 2666

1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-3, 11-14, 16-22, 24-28, 32-33 and 40-43 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 7-10 and 30-31 of copending Application No. 10/059,753. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 7-10 and 30-31 recite or have inherent all the limitations of claims 1-3, 11-14, 16-22, 24-28, 32-33 and 40-43 the present invention, except for additionally reciting blocking communications between devices not in a common zone. Claims 1-3, 11-14, 16-22, 24-28, 32-33 and 40-43 merely broaden the scope of the claims of the '753 application by eliminating elements and their functions from the claims. It has been held that omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. *In re Karlson*, 136 USPQ 184 (CCPA). Also note *Ex parte Rainu*, 168 USPQ 375 (Bd. App. 1969) (omission of a reference element whose function is not needed would be obvious to one skilled in the art). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to not recite blocking packets as a way for restricting communications between devices not of a common zone.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-2, 11, 15-23, 26-27, 32-33, 39-43, 46 are rejected under 35 U.S.C. 102(e) as being anticipated by Berman (US 2003/0095549).

4. Regarding claims 1, 19-20, 26-27, 32-33, 42 and 46, Berman discloses a method for use in a system comprising a first fabric (Figure 10; abstract, lines 1-5; para 190) and several devices coupled to the fabric by Fibre Channel connections (para. 183, lines 4-5). The method comprises accessing a definition of a first configuration including at least one zone in an inherent storage medium (para. 8, lines 1-3 and last three lines; paras. 15 and 19) having at least one member and restricting communications between the devices coupled to the first fabric (para. 8, last three lines; para. 24, lines 1-3; para. 30; para. 156). Further regarding claims 27 and 32, the system includes a login device (paras. 23 and 132). Further regarding claims 33 and 42, the system implements instructions on a computer readable medium (Figure 15).

5. Regarding claim 2, several configurations are available (Figures 1 and 6-13; para. 21).

6. Regarding claims 11 and 39, members with private communication have restricted communication (para. 8, lines 1-3 and last three lines).

7. Regarding claims 15 and 40, the name or address of a device is independent of its location (para. 21; note: the physical location of the device can not be exactly determined based on the assigned address because the device chooses an address within an assigned set).
8. Regarding claims 16-18 and 41, the name includes a worldwide port name or worldwide node name (paras. 97, 126 and 136-137) or ALPA (paras. 21 and 165).
9. Regarding claims 21-22, a configuration is stored for a new device to the fabric (para. 175).
10. Regarding claims 23 and 43, when a first fabric and a second fabric are merged (Figure 25), the definitions of the configurations are modified to allow communications between the first fabric and the second fabric (paras. 154,156, 161-162).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 3 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berman as applied to claim 1 or 27 above, and further in view of Brunson (US 5,329,579).

11. Regarding claims 3 and 28, Berman does not disclose a non-volatile memory for storing the configuration and reinstating the configuration after power loss. Brunson discloses using a non-volatile memory for storing control information in a device so that the device may function properly

Art Unit: 2666

and similarly after a power outage (col. 5, lines 26-29 and 35-38). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to have a non-volatile memory in the invention of Berman for storing a system configuration and for reinstating the configuration in the event of a loss of power.

Allowable Subject Matter

12. Claims 4-6, 12-13, 24-25, 29, 34-38 and 44-45 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, including overcoming any double patenting rejections, if applicable.

13. Claims 47-50 are allowed.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Stoevhase (US 5,805,924) discloses multiple zones in a Fibre Channel network (Figure 7; col. 13, line 61 through col. 14, line 5).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin Harper whose telephone number is 703-305-0139. The examiner can normally be reached weekdays, except Wednesday, from 9:30 AM to 8:00 PM ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Seema S. Rao, can be reached at 703-308-5463. The centralized fax number for the Patent Office is 703-872-9306.

Art Unit: 2666

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Customer Service Office for TC 2600 at 703-306-0377.

Kevin C. Harper



December 1, 2003

Seema S. Rao

SEEMA S. RAO 12/1/03
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600